

REMARKS

In light of the above amendments and remarks to follow, reconsideration and allowance of this application are respectfully requested.

Claims 1, 4, 41 and 45 were amended. Claims 1, 3-5, 41-42, 45-46, 48-50 and 52 are pending.

Claims 1, 3-5, 41-42, 45-46, 48-50 and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik et al. (U.S. Patent 6,233,684; "Stefik I") in view of Stefik et al. (U.S. Patent 5,629,980; "Stefik II").

In the subject Office Action, the Examiner stated that the wording:

[the receiving unit] is inhibited from one of the use of and an operation of the use permission data, while the controller is sending the use history information . . .

which follows the "wherein" clause in each of claims 1, 4, 41 and 45, "merely states the result of the limitations in the claim" and, therefore, "adds nothing to the patentability or substance of the claim." It is respectfully submitted that the above-quoted wording, which was present only in independent claims 1 and 4, further defined the operation of the receiving unit and, therefore, did not reflect a result of the limitations of claims 1 and 4.

Nevertheless, to expedite prosecution of the application, and without acknowledging that the "wherein . . ." clauses of claims 1 and 4 did not further limit those claims, independent claims 1 and 4 have been amended, in relevant part, to recite:

a controller configured (i) to automatically send the use history information . . . when an accumulation of uses of the digital data reaches a preset value and (ii) to inhibit the receiving unit from one of the use of and an operation of the use permission data,

while the controller is sending the use history information . . .

(emphasis added). In addition, independent claim 41 has been amended to clarify that the claimed data reproducing terminal includes, in relevant part, a "control unit configured ... to inhibit the signal processing unit from performing the signal process, while the control unit is sending the reproduction history data to the exterior element." Similarly, claim 45 has been amended, in relevant part, to clarify that the control unit is "configured . . . to inhibit the writing of the reproduction history data into the memory unit, while the control unit is sending the reproduction history data to the exterior element." (See specification, for example, pg. 42, ln. 19-21 and pg. 53, ln. 11-17).

Accordingly, a controller (control unit) of the claimed invention is configured to inhibit the receiver unit or the signal processing unit, while the controller is sending use (reproduction) history information to an external device. The controller of the claimed invention, thus, advantageously provides that the decoding or reproduction of digital data is inhibited at the receiver unit or the signal processing unit, while use history information is being transferred, to "prevent[] the occurrence of a situation" where, for example, the history of the decoding or reproduction of digital data is not in the stored use history information. (See specification, for example, at pg. 52, ln. 23-pg. 53, ln. 20).

Although Stefik I appears to concern storing use history information for digital data, the applied portions of Stefik I do not appear to disclose or suggest a controller configured to inhibit a receiving unit or signal processing unit from decoding or reproducing the digital data, while the controller is sending use history information of the digital

data to an external device, as required by claims 1, 4 and 41. In addition, the applied portions of Stefik I do not appear to disclose or suggest a control unit configured to inhibit the writing of reproduction history data of digital data into the memory unit, while the control unit is sending the reproduction history data to an exterior element, as required by claim 45.

Stefik II does not cure the deficiencies of Stefik I with respect to the requirements of claims 1, 4, 41 and 45, as discussed above. Although the applied portions of Stefik II appear to describe sending use history information for a digital work when a use condition is satisfied, Stefik II does not disclose or suggest inhibiting reproduction or use of the digital work while the use history information is being sent. In particular, nowhere do the applied portions of Stefik II appear to disclose or suggest configuring a controller to automatically send the use history information of digital data to an external device when the uses reach a preset value, and to inhibit a receiving unit from use of and operation of the use permission data "while the controller is sending the use history information" to an external device, as required by claims 1 and 4.

In addition, nowhere do the applied portions of Stefik II appear to disclose or suggest configuring a control unit to automatically send the reproduction history data to an exterior element when the reproduction history data in the memory unit reaches a preset value, and to inhibit the signal processing unit from performing the signal process "while the control unit is sending the reproduction history data" to the exterior element, as required by claim 41. Further, the applied portions of Stefik II do not appear to disclose or suggest configuring a control unit to inhibit writing of reproduction history data into the memory unit, "while the control unit is

sending the reproduction history data" to the exterior element, as required by claim 45.

Accordingly, the combination of the applied portions of Stefik I and Stefik II does not obviate the claimed invention. Thus, Stefik I and Stefik II fail to meet all of the limitations of the present claims and the rejected claims should now be allowed.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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